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OFFICE OF PETITIONS

In re Application of :
Lipton et al. :
Application No. 10/613,866 : DECISION DISMISSING
Filed: 2 July, 2003 : PETITION
Atty Docket No. 300.82 :

This is a decision in reference to the petition styled under 37 CFR 1.182, filed on 3 December, 2003, which is treated as a petition under 37 CFR 1.53 requesting that the above-identified application be accorded a filing date of 2 July, 2003, with Figure 3 described in the specification as a part of the original disclosure.

The Office apologizes for the delay in responding to the present petition.

On 2 July, 2003, the application was filed.

On 1 October, 2003, the Office of Initial Patent Examination (OIPE) mailed a Notice of Omitted Item(s) in a Nonprovisional Application stating that, *inter alia*, the application had been accorded a filing date of 2 July, 2003, but that Figure 3 described in the specification (description and claims) appeared to have been omitted from the application.

In response, on 3 December, 2003 (certificate of mailing date 1 December, 2003), the present petition was filed, accompanied by a copy of seven (7) drawing sheets. Petitioners concede that Figure 3 was inadvertently omitted from the application papers filed on 2 July, 2003, but state that the omitted Figure 3 is "virtually identical" to a drawing figure contained in a provisional application, No. 60/393,605.

The petition is dismissed.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, however, petitioners neither assert that the missing drawing was deposited on 2 July, 2003, nor request the 3 December, 2003 (the date the drawing was supplied), filing date. Rather, petitioners simply state that the omitted Figure 3 is identical to a figure contained in another application.

MPEP 201.06(c) states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

However, a review of the transmittal letter and specification for the present application reveals that the prior provisional application, No. 60/393,605, was not incorporated by reference into the disclosure of this application. The mere reference to another application is not an incorporation of anything therein

into the application containing the reference.¹ To allow one to retroactively incorporate by reference a second application into a first application would allow the addition of matter into an application that was not present on filing which would be contrary to our statutes and rules. Still further, the question of new matter is not an issue here. Figure 3 was simply not filed in the USPTO on 2 July, 2003. Matter included in Figure 3 may be submitted as an amendment for consideration by the examiner under MPEP sections 608.02(p) and 608.04. In view of the above, the application cannot be accorded 2 July, 2003, as the application filing date with drawing Figure 3 as a part of the original disclosure.

Petitioners may wish to consider filing a petition under 37 CFR 1.182 requesting that the Office accord the application a filing date of 3 December, 2003, using the copy of Figure 3 supplied on that date.

The application will be processed using only the application papers present on filing. The copy of the seven (7) sheets of drawings filed with the present petition will not be processed for examination, but will be retained in the application file.

As this petition was not necessitated by an error on the part of the Office, the petition fee will not be refunded.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 2 July, 2003, using only the application papers filed on that date.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

¹ See In re de Seversky, 177 USPQ 144, 146 (C.C.P.A. 1973); Dart Industries v. Banner, 207 USPQ 273, 276 (D.C. Cir. 1980).